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19

Application Number	09/778,311
Filing Date	02/07/2001
First Named Inventor	Kevin Callahan
Art Unit	3623
Examiner Name	Sterrett, Jonathan G.
Attorney Docket Number	54151.07US1

ENCLOSURES (Check all that apply)

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Firm Name	Customer No. 34048 Greenberg Traurig, LLP		
Signature			
Printed name	Gary R. Jarosik		
Date	April 5, 2006	Reg. No.	35,906

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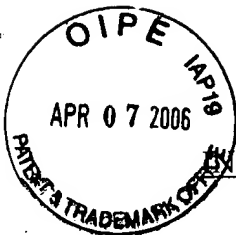
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Applicant:	Callahan)	Examiner:	Sterrett, Jonathan G.
)		
Serial No.:	09/778,311)	Art Unit:	3623
)		
Filed:	February 7, 2001)	Attny Doc.:	54151.07US1
)		
Title:	Methods And Apparatus For)		
	Scheduling An In-Home)		
	Appliance Repair Service)		

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's rejection of claims 1-19.

A timely Notice of Appeal has been filed.

This Appeal Brief is being filed in triplicate with the requisite fee.

The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

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By: Ranni Matar
Ranni Matar

I. Real Party In Interest

The real party in interest is Sears, Roebuck & Co.

II. Related Appeals And Interferences

There are no appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status Of The Claims

In the application, claims 1-19 remain pending and, having been at least twice rejected, are the subject of this appeal.

A clean, double spaced copy of pending claims 1-19 may be found in the attached Claims Appendix .

IV. Status Of Amendments

The claims are in condition for appeal – no further amendments to the claims are pending.

V. Summary Of The Claimed Subject Matter

With reference to the corresponding U.S. Published Application No. 2002/0107716, the claimed invention is directed to a method of scheduling an in-home appliance repair service by a customer. To this end, as generally illustrated in Figs. 1, 5 and 6 and described at paragraphs 0033+, the method is performed by receiving an appliance selection request message (508) at a server device (106) from a client device (102) via a wide area network (108) where the appliance selection request message is indicative of a desire to receive appliance selection data to be used to facilitate selection of a first home appliance by the customer, i.e., the appliance the customer wishes to have repaired. In response to the receipt of the appliance selection request message,

the appliance selection data (514) is transmitted from the server device (106) to the client device (102) via the wide area network (108). The customer may then interact with the appliance selection data whereupon the server device (106) receives (524) from the client device (102) via the wide area network (108) an appliance identifier and a geographical identifier. After the server device (106) receives the appliance identifier and the geographical identifier, the server device (106) determines (528) multiple available repair time slots and the server device (106) then transmits (530) to the client device (102) via the wide area network (108) data indicative of the multiple available repair time to thereby allow the customer to select at least one of the multiple available repair time slots. The server device (106) then receives (540) from the client device (102) via the wide area network (108) time slot selection data which functions to indicate a desire by the customer to have the appliance repaired in the one of the multiple available repair time slots selected by the customer.

VI. Grounds Of Rejection To Be Reviewed On Appeal

1. Whether the rejection claims 1-19 under 35 U.S.C. § 103 can be maintained when the references being relied upon simply fail to disclose, teach, or suggest, when considered in combination, each and every element set forth in the claims, considering the claims “as a whole.”

2. Whether the rejection of claims 1-19 under 35 U.S.C. § 103 can be maintained when the rejection of claims 1-19 reflects the impermissible use of hindsight reasoning.

VII. Argument

A) Summary Of The Rejection Of Claims 1-19

The pending claims presently stand rejected under 35 U.S.C. § 103 as being rendered

obvious primarily in view of the combination of “Whirlpool.com” and “PointServe.” In this regard, “Whirlpool.com” is being used by the Examiner as a general reference for the combination of “KitchenAid Appliance Diagnostic System” (reference A); “KitchenAid Repair Service Locator” (reference B); Whirlpool webpage of air conditioners hypertext links of specific models (reference F); and Whirlpool webpage “Service Matter” (reference G) while “PointServe” is being used by the Examiner as a general reference for the combination of “Right Place, Right Time” (reference U1); “PointServe Launches Breakthrough On-line Scheduling Solutions To Dramatically Improve Reliability Of Home And Business-Oriented Service Delivery Regional Rollout To Begin In Salt Lake City On Nov. 1...” (reference V1); “Rocket Scientist Tries Improving Service Industry” (reference W1); and “New Service Website Holds Promise For Contractor” (reference X1).

In rejecting independent claim 1 under 35 U.S.C. § 103, it was asserted that “Whirlpool.com” teaches all of the claim elements excepting the claimed “determining at the server device multiple available repair time slots based on at least one of the appliance identifier and the geographical identifier provided by the customer; transmitting data indicative of the multiple available time slots from the server device to the client device via the wide area network to thereby allow customers to select at least one of the multiple repair time slots; and receiving time slot selection data at the server device from the client device via the wide area network, the time slot selection data indicating a desire by the customer to have the first home appliance repaired in the one of the multiple available repair time slots selected by the customer.” It was, however, asserted that “PointServe” discloses these claimed elements. (citing to V1 at page 2, para. 8, lines 1-3; W1 at page 1, para. 6, lines 1-3; U1 at page 1, para. 5, lines 1-4; and V1 at page 2, para. 2, lines 1-2). It was therefore concluded that it would have been obvious to modify

the teachings of “Whirlpool.com” with the step of determining, transmitting, and receiving multiple time slot selection data to and from customers over the Internet for scheduling an appliance repair, as allegedly taught by “PointServe,” for the reason that it would “improve customer satisfaction with the home service industry.”

B) Applicable Case Law

It is respectfully submitted that, when evaluating the scope of a claim, every element in the claim must be considered. *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Furthermore, the claimed invention may not be dissected into discrete elements to be analyzed in isolation, but must be considered “as a whole.” *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Thus, to establish a *prima facie* case of obviousness, all of the claim elements must be expressly or inherently described in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). To be “inherently” described in a reference the reference “must make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill.” Inherency “may not be established by probabilities or possibilities.” The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264 (Fed. Cir. 1991).

Still further, when evaluating a claim for obviousness, it is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the

claimed invention. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

C) The References Fail To Disclose The Claims “As A Whole”

In response to the rejection of claims 1-19, it is respectfully submitted that the combination of “Whirlpool.com” and “PointServe” fails to include each and every element set forth in the claims, considering each and every word, as is required to maintain a *prima facie* case of obviousness.

More particularly, it is respectfully submitted that the isolated passages from within the “PointServe” references relied upon in the rejection of the claims simply cannot be said to expressly disclose or inherently disclose, i.e., “make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill,” the claim elements which the Examiner has acknowledged are missing from “Whirlpool.com” in the first place.

In the rejection of the claims it has been acknowledged that “Whirlpool.com” fails to disclose, teach, or suggest at least the *combination* of claims elements directed to “determining at the server device multiple available repair time slots based on at least one of the appliance identifier and the geographical identifier provided by the customer; transmitting data indicative of the multiple available time slots from the server device to the client device via the wide area network to thereby allow customers to select at least one of the multiple available repair time slots; and receiving time slot selection data at the server device from the client device via the wide area network, the time slot selection data indicating a desire by the customer to have the first home appliance repaired in the one of the multiple available time slots selected by the customer.” It is respectfully submitted that the various references that comprise “PointServe”

likewise fail to disclose this *combination* of claim elements and, as such, cannot be said to suggest modifying “Whirlpool.com” to arrive at the invention set forth in the claims.

Turning now to the “PointServe” references, namely, cited references W1, V1 and U1, it has been asserted that reference V1 discloses on page 2, paragraph 8, lines 1-3 the claimed element of “determining at the server device multiple available time slots based on at least one of the appliance identifier and the geographic identifier provided by the customer.” While this passage does disclose using “geographic information systems (GIS) routing capabilities” as asserted in the rejection of the claims, what is not expressly or inherently disclosed within the cited passage, or anywhere else in the “PointServe” references, is that the “geographic information systems (GIS) routing capabilities” *are ever used to determine multiple available time slots which are thereafter, in keeping with the remainder of the claim elements, transmitted to a client device whereby a consumer may selected one of the time slots for use in scheduling a repair.* Rather, this cited passage describes nothing more than the fact that the “geographic information systems (GIS) routing capabilities” are used by the “ServiceXchange” component of the “PointServe” system and that the “ServiceXchange” component of the “PointServe” system is used by service providers to do nothing more than manage, in real-time, the scheduling, routing, tracking, and delivery elements of their services, i.e., to manage service personnel *to meet already scheduled service appointments.* Thus, it is respectfully submitted that this isolated passage from the “PointServe” references simply cannot be said to evidence that it would have been obvious to modify “Whirlpool.com” to include “determining at a server device multiple available repair time slots based on at least one of the appliance identifier and the geographic identifier provided by the customer and transmitting data indicative of the multiple available repair time slots [so determined] from the server device to the client device via the wide area

network to thereby allow a customer to select at least one of the multiple available repair time slots...” as is claimed *in combination*. For at least this reason it is respectfully submitted that the cited references fail to present a *prima facie* case of obviousness and the rejection must be withdrawn.

As further concerns the consumer selecting a time slot for use in scheduling a repair, while cited to references W1 at page 1, paragraph 6, lines 1-3, reference U1 at page 1, paragraph 5, lines 1-4, and reference V1 at page 2, paragraph 2, lines 1-2, may describe making repair time slots available to the consumer for selection via a network client device, what is not expressly or inherently described within these isolated passages or anywhere else in the “PointServe” references is that the repair time slots that are made available to the customer for selection are those that have been, *in keeping with claim language*, determined at the server device based on at least one of the appliance identifier and the geographical identifier provided by the customer. Rather than disclose, teach, or suggest this specific aspect of the claimed invention, the “PointServe” references disclose a system, as seen in reference U1 at page 1, paragraph 5, lines 1-4, where the consumer merely selects a repair time slot from a list of all repair slots that have not already been assigned, i.e., open spaces that exist in a company’s schedule for service providers. That the “PointServe” reference U1 discloses nothing more than a consumer merely picking from the open, candidate slots has been acknowledged by the Examiner. (*see* Office Action of February 1, 2006 at page 9). Accordingly, since the “PointServe” references are limited to a system that provides to a consumer time slots that have been “determined” by doing nothing more than checking for times that service personnel presently have free, it is respectfully submitted that the “PointServe” references simply cannot be said to evidence that it would have been obvious to modify “Whirlpool.com” to include “determining at a server device multiple

available repair time slots based on at least one of the appliance identifier and the geographic identifier provided by the customer and transmitting data indicative of the multiple available repair time slots [so determined] from the server device to the client device via the wide area network to thereby allow a customer to select at least one of the multiple available repair time slots...” as is claimed *in combination*. For at least this reason it is respectfully submitted that the cited references fail to present a *prima facie* case of obviousness and the rejection must be withdrawn.

In sum, it will be appreciated that the “PointServe” references fail to disclose, teach, or suggest that which has been acknowledged to be missing from “Whirlpool.com.” Furthermore, it will be appreciated that the “PointServe” references suggest a system that is in direct contrast to that which is claimed. In particular, rather than disclose, teach, or suggest a system in which one of an appliance identifier and geographical identifier provided by a customer is first used to determine multiple available repair time slots after which the multiple available repair time slots are provided to a consumer to thereby allow the consumer to select one of the multiple available repair time slots in which to schedule a repair, the “PointServe” references suggest a system in which a user is first presented with nothing more than a list of all open repair time slots from which the user may select one in which to schedule a repair and a system which then uses “geographic information systems (GIS) routing capabilities” to allow the service provider to manage, in real-time, the scheduling, routing, tracking, and delivery elements of their services, i.e., to manage the scheduling, routing, tracking, of their service technicians to thereby ensure that at least one service technician will be available to meet the consumer within the repair time slot already scheduled by the consumer. Accordingly, having demonstrated that the “PointServe” references fail to include the disclosure required to support a *prima facie* case of

obviousness it is respectfully submitted that the rejection under 35 U.S.C. § 103 must be withdrawn.

D) The Rejection Of Claims 1-19 Reflects The Impermissible Use Of Hindsight

In the rejection of the claims, the Examiner has relied upon various isolated passages that the Examiner has picked from the “PointServe” references. Specifically, the Examiner has relied upon a first passage directed to allowing a consumer to schedule their own calls (while ignoring the fact that it is a selection made from nothing more than all open repair time slots as acknowledged by the Examiner), a second passage directed to finalizing the scheduled slot when the consumer requests it (while ignoring the fact that this processing is not performed *prior* to the consumer being presented time slots for selection), and a third passage directed to taking into account a customer’s location in the routing and scheduling of service calls (while ignoring the fact that this refers to nothing more than *the service provider* using the system to ensure a technician is available to meet an already scheduled service call) to conclude that the “PointServe” references suggest determining multiple available repair time slots based on a geographic location to thereby allow a customer to select one of the repair time slots so determined to arrange and schedule a variety of services at their home. It is, however, respectfully submitted that the Examiner has been forced to rely upon these multiple, isolated passages from the “PointServe” references for the simple reason that no single passage from within the “PointServe” references actually discloses that the “PointServe” system determines multiple available repair time slots based on a geographic location to thereby allow a customer to select one of the repair time slots so determined to arrange and schedule a variety of services at their home (which “PointServe” simply does not). Accordingly, since it has been demonstrated that the passages from the “PointServe” references that have been relied upon by the Examiner

do not disclose, teach, or suggest, whether considered alone or in combination, this aspect of the invention claimed, it is respectfully submitted that any conclusion that the "PointServe" references suggest modifying "Whirlpool.com" to arrive at the invention claimed could only have been reached by the Examiner impermissibly using the Appellants' disclosure as a template to pick and piece together the isolated passages from the "PointServe" references and to infer what those isolated passages might have suggested to one of skill in the art. For this yet further reason it is respectfully submitted that a *prima facie* case of obviousness has not been established and the rejection of the claims must be withdrawn.

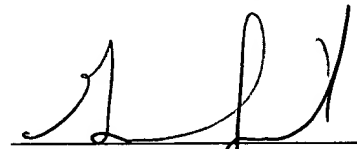
E) Conclusion

It is respectfully submitted that, when the claims are considered *as a whole*, the claims are neither anticipated by nor rendered obvious by the art of record. As such, it is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: April 5, 2006

By:



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VIII. CLAIMS APPENDIX

The following is a clean copy of the claims involved in the Appeal:

Listing of claims:

1. A method of scheduling an in-home appliance repair service by a customer, the method comprising the steps of:

receiving an appliance selection request message at a server device from a client device via a wide area network, the appliance selection request message being indicative of a desire to receive appliance selection data, the appliance selection data facilitating selection of a first home appliance by the customer;

transmitting the appliance selection data from the server device to the client device via the wide area network in response to receiving the appliance selection request message;

receiving an appliance identifier at the server device from the client device via the wide area network, the appliance identifier being provided by the customer and distinguishing the first home appliance from a second home appliance;

receiving a geographical identifier provided by the customer at the server device from the client device via the wide area network;

determining at the server device multiple available repair time slots based on at least one of the appliance identifier and the geographical identifier provided by the customer;

transmitting data indicative of the multiple available repair time slots from the server device to the client device via the wide area network to thereby allow the customer to select at least one of the multiple available repair time slots; and

receiving time slot selection data at the server device from the client device via the wide area network, the time slot selection data indicating a desire by the customer to have the first

home appliance repaired in the one of the multiple available repair time slots selected by the customer.

2. A method as defined in claim 1, further comprising the step of dispatching an agent of an appliance repair provider based on the time slot selection data.

3. A method as defined in claim 1, further comprising the step of repairing the first home appliance, wherein the step of repairing the first home appliance is performed after the step of receiving time slot selection data from the client device via the wide area network.

4. A method as defined in claim 1, wherein the step of receiving an appliance selection request message comprises the step of receiving a hypertext transport protocol (HTTP) message.

5. A method as defined in claim 1, wherein the step of receiving an appliance selection request message from a client device comprises the step of receiving an appliance selection request message from at least one of a personal computer (PC), a personal digital assistant (PDA), an Internet appliance, and a cellular telephone.

6. A method as defined in claim 1, wherein the step of transmitting the appliance selection data comprises the step of transmitting web page data.

7. A method as defined in claim 1, wherein the step of transmitting the appliance selection data comprises the step of transmitting a list of model numbers.

8. A method as defined in claim 1, further comprising the steps of: receiving a user identifier provided by the customer at the server device from the client device via the wide area network, wherein the user identifier functions to identify the customer to the server device; and retrieving a list of model numbers from a purchase history database based on the user identifier, wherein the step of transmitting the appliance selection data comprises the step of transmitting the list of model numbers retrieved from the purchase history database.

9. A method as defined in claim 1, wherein the step of transmitting the appliance selection data comprises the step of transmitting a digital picture of an appliance.

10. A method as defined in claim 1, wherein the step of transmitting the appliance selection data comprises the step of transmitting data indicative of a model number input area.

11. A method as defined in claim 1, wherein the step of transmitting the appliance selection data comprises the step of transmitting data indicative of a search engine query area.

12. A method as defined in claim 1, wherein the step of receiving an appliance identifier comprises the step of receiving an appliance model number.

13. A method as defined in claim 1, wherein the step of receiving an appliance identifier comprises the step of receiving an identifier associated with the appliance selection data.

14. A method as defined in claim 1, wherein the step of receiving a geographical identifier comprises the step of receiving at least one of a city identifier, a state identifier, a house number, a street name, a zip code, and an area code.

15. A method as defined in claim 1, wherein the step of determining multiple available repair time slots based on the appliance identifier comprises the step of querying a database of predetermined appliance repair providers for a particular appliance repair provider associated with the appliance identifier.

16. A method as defined in claim 15, wherein the step of determining multiple available repair times slot further comprises the step of receiving schedule data from the particular appliance repair provider.

17. A method as defined in claim 1, wherein the step of determining multiple available repair time slots based on the appliance identifier and the geographical identifier comprises the step of querying a database of predetermined appliance repair providers for a particular appliance repair provider associated with the geographical identifier.

18. A method as defined in claim 17, wherein the step of determining multiple available repair time slots further comprises the step of receiving schedule data from the particular appliance repair provider.

19. A method as defined in claim 1, wherein the step of transmitting data indicative of the

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multiple available repair time slots comprises the step of transmitting web page data.

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IX EVIDENCE APPENDIX

No evidence was submitted pursuant to Secs. 1.130, 1.131, or 1.132.

X. RELATED PROCEEDINGS APPENDIX

No decisions have been rendered by a court or the Board in any proceedings identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37.